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19                  **UNITED STATES DISTRICT COURT**  
20                  **NORTHERN DISTRICT OF CALIFORNIA**  
21                  **SAN FRANCISCO**

22                  GENENTECH, INC. and  
23                  ROCHE PALO ALTO, LLC,

Case No. 3:11-cv-01925-JSW  
Related Case No. 3:11-cv-02410-JSW

24                  Plaintiffs and Counterclaim Defendants,

**JOINT CLAIM CONSTRUCTION AND  
PREHEARING STATEMENT  
PURSUANT TO PATENT LOCAL RULE  
4-3**

25                  v.

26                  SANDOZ, INC.

27                  Defendant and Counterclaim Plaintiff.

Date: April 10, 2012  
Time: 1:30 p.m.  
Ctrm: 11, 19th Floor  
Judge: Honorable Jeffrey S. White

1 Pursuant to Patent L.R. 4-3, Plaintiffs Genentech, Inc. (“Genentech”) and Roche Palo Alto  
2 LLC (“Roche Palo Alto”) and Defendant Sandoz Inc. (“Sandoz”), parties to the above-entitled  
3 action, jointly submit the following Joint Claim Construction and Prehearing Statement.

4 **A. The Construction of Terms on Which the Parties Agree**

5 The parties agree on the construction of the following terms in the claims of U.S. Patent No.  
6 6,083,953 (“the ‘953 patent”).

7 <b>Claim term</b>	8 <b>Agreed Construction</b>
9 2-(2-amino-1,6-dihydro-6-oxo-purin-9- 10 yl)methoxy-3-hydroxy-1-propanyl-L-valinate 11 hydrochloride (claim 1)	12 valganciclovir hydrochloride
13 antiviral pharmaceutical composition (claim 2)	14 a pharmaceutical composition that has antiviral 15 activity
16 treating (claim 3)	17 any treatment of a disease in an animal, 18 including preventing, inhibiting or relieving the 19 disease
20 animal (claim 3)	21 human or non-human animal
22 administering (claim 3)	23 introducing [the compound] into an animal’s 24 body
25 is administered (claims 4, 6)	26 [the compound] is introduced into an animal’s 27 body

28 **B. Proposed Constructions of the Disputed Term**

19 The parties disagree on the construction of a single term in claim 1 of the ‘953 patent. Their  
20 proposed constructions, and the intrinsic and extrinsic evidence upon which they rely, are set forth in  
21 the chart below.

22 <b>Claim language (disputed term in bold)</b>	23 <b>Plaintiffs’ Proposed Construction and Evidence in Support</b>	24 <b>Defendant’s Proposed Constructions and Evidence in Support</b>
25 2-(2-amino-1,6-dihydro-6- 26 oxo-purin-9-yl)methoxy-3- hydroxy-1-propanyl-L- valinate hydrochloride <b>in 27 crystalline form</b>	28 in a physical form having molecules arranged in a regularly repeating three dimensional pattern	prepared in a stable, solid physical form having molecules arranged in a regularly repeating three dimensional pattern

<b>Claim language (disputed term in bold)</b>	<b>Plaintiffs' Proposed Construction and Evidence in Support</b>	<b>Defendant's Proposed Constructions and Evidence in Support</b>
	<p><u>Intrinsic evidence:</u></p> <p>‘953 patent specification: col. 1, ll. 19-27 col. 5, ll. 47-52 col. 10, ll. 50-55 col. 14, ll. 49-50 col. 15, ll. 5-9 col. 20, ll. 56-65 col. 21, ll. 19-49 col. 23, l. 18 to col. 25, l. 22 col. 27, l. 35 to col. 29, l. 33 col. 30, claims 1, 2</p> <p>Application No. 08/281,893 as originally filed, pp. 19-20, 28-29, 31-33, 41.</p> <p>Application No. 08/453,223, Amendment dated May 24, 1996, pp. 2, 6, 14-17.</p> <p>Application No. 08/812,991, Response dated June 7, 1999, p. 2</p> <p>Application 09/418,535, Amendment dated August 24, 2000, p. 3.</p> <p><u>Extrinsic evidence:</u></p> <p>Remington's Pharmaceutical Sciences 172 (Alfonso R. Gennaro ed., (8th ed. 1990)</p> <p>23 The New Encyclopaedia Britannica 612-643 (Encyclopaedia Britannica, Inc., 15th ed. 1994)</p>	<p><u>Intrinsic evidence:</u></p> <p>‘953 patent specification: col. 3, ll. 32-34 col. 5, ll. 53-63 col. 15, ll. 7-9 col. 21, ll. 19-43</p> <p>Example 3B (col. 23, l. 49- col. 24, l. 8)</p> <p>Example 4 (col. 24, ll. 10- 33)</p> <p>Application No. 08/453,223, Paper No. 8 Amendment Under 37 CFR 1.111, filed May 28, 1996: pages 6, 14-17, and 45-46.</p> <p>Application No. 08/453,223, Paper No. 17, Appeal Brief, filed September 9, 1997: pages 4-5.</p> <p>Application No. 08/453,223, Paper No. 19, Reply Brief, filed January 12, 1998: pages 1-6.</p> <p>Application No. 08/453,223, Paper No. 23, Response to Final Rejection, filed September 8, 1998: pages 2-4</p> <p>Application No. 08/453,223, Declaration of Charles Dvorak, dated April 8, 1999: entire document.</p> <p>Application No. 08/453,223, Declaration of Yeun-Kwei Han, dated April 8, 1999: entire document.</p> <p>Application No. 08/453,223, Declaration of Hans Maag, dated April 8, 1999: entire document.</p> <p>Application No. 08/453,223, Paper No. 28, Appeal Brief, filed April 12, 1999: pages 3-10.</p> <p>Application No. 08/812,991,</p>

1 2 3 4 5 6 7 8 9 10 11 12 13 14 15 16 17 18 19 20 21 22 23 24	Claim language (disputed term in bold)	Plaintiffs' Proposed Construction and Evidence in Support	Defendant's Proposed Constructions and Evidence in Support
		<p>Order Construing Terms of U.S. Patent No. 6,083,953 from <i>Roche Palo Alto LLC v. Endo Pharmaceuticals, Inc.</i>, C.A. No. 10-261 (GMS) (D. Del. August 11, 2011)</p> <p>Valcyte Label (August 2010 Revision).</p> <p>Vogel's Textbook of Practical Organic Chemistry (B.S. Furniss et al., eds., 5th ed. 1989), pp. 135-136.</p> <p>S. Lohani and D.J.W. Grant, Thermodynamics of Polymorphs. <i>In: Polymorphism in the Pharmaceutical Industry</i> (R. Hilfiker, ed. 2006), p. 21</p> <p>J.K. Guillory, Generation of Polymorphs, Hydrates, Solvates, and Amorphous Solids. <i>In: Polymorphism in Pharmaceutical Solids</i> (H.G. Brittain, ed. 1999), pp. 184-185, 208-219.</p> <p>International Patent Application Publication WO 2008/122105 A1, Abstract and p.2.</p> <p>International Patent Application Publication WO 2009/024997 A1, Abstract and pp. 7-8.</p>	<p>Response to Office Action, dated June 10, 1999: pages 2-10.</p> <p>Application 09/418,535, Amendment dated August 24, 2000, pages 3-5.</p>

25      **C. Terms Whose Construction Will Be Most Significant to the Resolution of the Case**

26      The parties believe that the sole disputed term is the most significant for resolution of this  
27 case. Claim 1 is the only independent claim in the '953 patent. As such, claim 1 affects the  
28 remaining claims of the patent.

**D. The Anticipated Length of Time Necessary for the Claim Construction Hearing**

The parties believe that the claim construction hearing in this case and the related case should be completed within three hours, to be equally divided between Plaintiffs Genentech and Roche Palo Alto (1.5 hours) and Defendants Sandoz and Apotex (1.5 hours).

**E. Whether Any Party Proposes To Call One or More Witnesses**

The parties do not propose to rely on live or deposition testimony of witnesses for purposes of claim construction

Dated: November 28, 2011

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**SANDOZ INC.**

I, Joshua H. Lerner, am the ECF User whose identification and password are being used to file this document. Pursuant to General Order 45.X.B, I hereby attest that counsel for Defendant Sandoz Inc. has concurred in this filing.

*/s/ Joshua H. Lerner*